

REMARKS

Claim Amendment

Claims 1-4, 7, 8, 11-20 and 52 are pending in this application for the Examiner's review and consideration. Claim 20 has been amended to delete the term "capable of being" to more particularly point out and recite the claimed invention. As no new matter is introduced by the amendment, Applicants respectfully request its entry into the record of the present application. Applicants also reserve the right to re-present the claims and to file divisional or other continuing applications for subject matter disclosed but not claimed in the present application.

Correction of Inventorship

The Examiner states that the "Request for Correction of Inventorship," submitted August 11, 2003, is deficient because no statement of Mr. Thomas was actually submitted. Applicants respectfully point out, and submit prove herein, that a statement by Mr. Thomas was indeed submitted.

Applicants enclose herein copies of all papers submitted in the August 11, 2003 response, as proved by and specifically itemized in the Return Receipt Postcard, stamped by the OIPE:

Petition for Extension of Time Under 37 C.F.R. § 1.136(a);
Response to Non-Final Office Action;
Request for Correction of Inventorship;
Petition and Statement in Support of Correction of Inventorship Under
37 C.F.R. § 1.48(a)
Declaration for Non-Provisional Patent Application; and
Consent by Assignee to Correction of Inventorship with Exhibit A.

Applicants respectfully submit that the Request for Correction of Inventorship, as filed on August 11, 2003, was not deficient, but had satisfied all requirement under 37 C.F.R. § 1.48(a).

The Double Patenting Rejections

Claims 1-4, 7, 8, and 11-20 were rejected over the claims of U.S. Patent Application No. 6,436,424 (“the ‘424 patent”) and provisionally rejected over the pending claims of U.S. Patent Application No. 10/222,819 (“the ‘819 application”) under the judicially created doctrine of obviousness-type double patenting for the reasons set forth on pages 2 and 3 of the Office Action.

Although Applicants respectfully disagree with the Examiner’s assertion and maintain the position as stated in the response filed on August 11, 2003, Applicants have submitted herein a Terminal Disclaimer that disclaims the terminal part of any patent granted from the present application that would extend beyond the earlier of the expiration dates of the ‘424 and any U.S. patent that issues from the ‘819 application.

Applicants respectfully submit that the obviousness-type double patenting rejections have been overcome and should be withdrawn.

The Rejections Under 35 U.S.C. § 112

Claim 20 was rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth on pages 3 and 4 of the Office Action.

The Examiner has alleged that the term “capable of” in claim 20 “is vague and indefinite, as it is confusing and conveys no limitations to the instant claims, ...” Office Action at page 4. Applicants respectfully disagree.

Although Applicants respectfully disagree with the Examiner’s assertion and maintain the position as stated in the response filed on August 11, 2003, Applicants have amended claim 20, as suggested by the Examiner. Therefore, the rejection of claim 20, under 35 U.S.C. § 112, second paragraph, is moot and should be withdrawn.

The Rejection Under 35 U.S.C. § 103

Claims 1-4, 7, 8, 11-20 and 52 were rejected by the Examiner under 35 U.S.C. § 103(a) as being obvious over PCT publication WO 99/44643 to Vogel et al. ("Vogel") in view of U.S. Patent No. 5,922,025 to Hubbard ("Hubbard"). Applicants respectfully traverse this rejection.

Applicants submit that Vogel should be removed as a prior art reference to the present invention under either 35 U.S.C. § 102 or § 103, because the inventive entity in Vogel and the present application is the same* and that Vogel was published within one year of the effective filing date of the present application. Thus, Vogel is not a prior art to the present invention.

Applicants further submit that Hubbard does not obviate the claimed invention for the following reasons. Hubbard discloses an augmentation material comprising smooth rounded, substantially spherical, particles of a finely divided ceramic material. Hubbard at col. 5, lines 1-3 and lines 36-37. Hubbard does not disclose a composition for dermal augmentation that comprises biocompatible, swellable, hydrophilic, non-toxic and substantially spherical microspheres, as presently claimed. Hubbard further fails to disclose or suggest a composition that comprises microspheres that swell to a predetermined size after injection, much less microspheres that swell after injection up to four times their pre-injection size, as presently claimed. In fact, the finely divided ceramic particles disclosed in Hubbard are, by definition, the direct opposite of the swellable and hydrophilic characters of the microspheres required by the present invention. In addition, Applicants respectfully draw the Examiner's attention to page 10, lines 9-15 of the specification, where "microspheres" are defined as "polymer or combination of polymers made into bodies of various sizes." In other words, Hubbard is totally silent with regard to swellable, hydrophilic, and polymer, all of which are required by the presently claimed invention.

* A Request for Correction of Inventorship and other required documents, which adds Richard Thomas as an inventor of the present application, were submitted on August 11, 2003.

Applicants further submit that, Hubbard not only fails to suggest the present invention, but actually teaches away from it by emphasizing the use of particles made from ceramic and aluminum materials, which cannot be swellable, hydrophilic, or a polymer, as required by the present invention. In other words, one of ordinary skill in the art, based on the disclosure in Hubbard, *i.e.*, solid rigid particles, would look away from the direction of the present invention, *i.e.*, soft swellable microspheres.

For the foregoing reasons, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

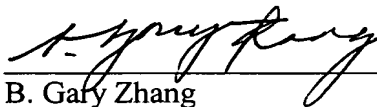
Conclusion

Applicants respectfully submit that, in view of the amendment and remarks made herein, all pending claims are now in condition for allowance, early notice of which is earnestly solicited. Should the Examiner disagree, a personal or telephonic interview is respectfully requested to resolve any remaining issues in this application.

No fee is believed to be due for the submission of this response, except the fee for the Petition for Extension of Time Submitted herein. Should any additional fee be required, however, please charge such fee to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date: May 26, 2004


B. Gary Zhang

(Reg. No. 47,331)

For: Anthony M. Insogna

(Reg. No. 35,203)

JONES DAY
51 Louisiana Avenue, N.W.
Washington, D.C. 20001-2113
(202) 879-3939

Enclosure